

**REMARKS**

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Reconsideration of Claims 1-20, as amended, is respectfully requested.

**Claim Rejections under 35 U.S.C. § 102(b)**

The Office Action mailed September 22, 2005, rejected Claims 1 and 4-7 as anticipated by Worthington (US2002/0121792, hereinafter "Worthington").

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Claim 1 requires:

A tool for lifting a pad, comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having a sloped upper surface for slidably receiving a portion of the pad;

a first member pivotally coupled to the non-pivoted jaw structure; and

a second member pivotally coupled to the first member, the second member having a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards.

It is initially important to address a factually erroneous assertion of the outstanding Office Action, regarding the claim limitation of a “sloped surface.” The Office Action states, in relation to this term, “(relative term, also zero or 90 degree slope is still a slope)”. While, in mathematics, a slope can certainly equal 0 or 90 degrees, the term “sloped” is never used in that manner. “Sloped”, in common usage, is an adjective meaning having an oblique or slanted direction. The Cambridge Dictionary of American English defines “sloped” as “a surface that rises at an angle, esp. a hill or mountain, or the angle at which something rises” (printout of relevant page attached). The Office Action appears to interpret “sloped” as “flat”, which is in clear contradiction to the plain language of the claims, and is clearly factually erroneous. The Examiner is invited to produce any documentary evidence that teaches that “sloped” means “flat.”

Claim 1 first requires “a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having a sloped upper surface for slidably receiving a portion of the pad.” The Office Action equates the “non-pivoted jaw structure” with Worthington’s U-shaped bracket 16, the extension 38 as the “upper jaw portion”, and U-shaped bracket 15 combined with cushion insert 36 as the “lower jaw portion.” Worthington does not teach or suggest that U-shaped

bracket 15 combined with cushion insert 36 has a sloped upper surface, as required by this claim, so Worthington fails to teach the limitations of Claim 1.

Claim 1 further requires “a second member pivotally coupled to the first member, the second member having a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards.” The Office Action equates the “second member” with Worthington’s plate 14. However, Worthington’s plate 14 does not have “a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface” as required by claim 1, as there is no sloped surface demonstrated to be opposite of. In fact, Worthington describes that “the gripping surfaces 34 and 44 to be oriented so that they are exactly parallel to one another” (see [0023]), so that Worthington teaches directly away from the claimed sloped surface.

As may be clearly seen, the features of Claim 1 are not taught or suggested by Worthington, and so Claim 1 and dependent claims 2-7 should be allowed over Worthington. These rejections are traversed.

Claims 1-5, 7-11, and 14 were rejected as anticipated by Krauss (US 6,086,126, hereinafter “Krauss”). Claim 1 first requires “a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having a sloped upper surface for slidably receiving a portion of the pad.” The Office Action equates the “non-pivoted jaw structure” with Krauss’s “gripping slot” 20, the “upper jaw portion” and the “lower jaw portion” as edges 20a and 20b of

gripping slot 20, respectively. The edges 20a and 20b are described as “enlarged toward the outside”, not as “sloped”.

Claim 1 further requires “a first member pivotally coupled to the non-pivoted jaw structure”. The Office Action equates the claimed “first member” with Krauss’s torsion spring 32. Nothing in Krauss teaches or suggests that the torsion spring 32 is “pivotally coupled” to gripping slot 20, as would be required by claim 1. Torsion spring 32 is described as “mounted on the fixing pin (30)” and resting against the side of claiming element 26. As such, Krauss fails to teach or suggest the limitations of claim 1.

Claim 1 further requires “a second member pivotally coupled to the first member, the second member having a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards.” The Office Action equates the claimed “second member” with Krauss’s claiming element 26. However, claiming element 26 does not clamp a portion of any pad against a sloped surface when torsion spring 32 is pivoted upwards, as would be required by claim 1. Further, clamping element 26 does not appear to have any surface opposite a sloped surface of edge 20b at all. As such, Krauss fails to teach or suggest the limitations of claim 1.

As may be clearly seen, the features of Claim 1 are not taught or suggested by Krauss, and so Claim 1 and dependent claims 2-7 should be allowed over Krauss. These rejections are traversed. Claim 8 includes limitations similar to those discussed above with regard to claim 1, and the distinctions over Krauss with regard to claim 1 apply to claim 8 as well. As such, the features of

Claim 1 are not taught or suggested by Krauss, and so Claim 8 and dependent claims 8-14 should be allowed over Krauss. These rejections are traversed.

**Claim Rejections Under 35 U.S.C. § 103 (a)**

The final Office Action of September 22, 2005 rejected Claims 2, 3, and 8-20 under 35 U.S.C. § 103(a) as being unpatentable over Worthington in view of Krauss. With regard to claims 2, 3, and 8-14, the foregoing has demonstrated that limitations of independent claims 1 and 8 are not taught or suggested by Worthington or Krauss. As each of them fails to teach or suggest claim limitations, the combination of these references similarly fails to teach or suggest the claim limitations. These claims should be allowed over the art of record, and these rejections are traversed.

Claim 15 requires:

A chemical mechanical polishing pad removal tool; comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the upper jaw portion having an arcuate lower surface for contacting portions of an upper surface of the chemical mechanical polishing pad, the lower jaw portion having a sloped upper surface spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the pad, the sloped upper surface terminating at a lower end in a rounded end;

a handle pivotally coupled to the non-pivoted jaw structure; and

a member pivotally coupled to the handle, the member having a textured surface projecting below the arcuate lower surface of the upper jaw portion and being opposite to the sloped surface of the lower jaw portion, the textured surface being operable for clamping the portion of the pad against the sloped surface when the handle is pivoted upwards.

Claim 15 first requires “non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the upper jaw portion having an arcuate lower surface for contacting portions of an upper surface of the chemical mechanical polishing pad, the lower jaw portion having a sloped upper surface spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the pad, the sloped upper surface terminating at a lower end in a rounded end”. As described above, the Office Action equates the “non-pivoted jaw structure” with Worthington’s U-shaped bracket 16, the extension 38 as the “upper jaw portion”, and U-shaped bracket 15 combined with cushion insert 36 as the “lower jaw portion.” Worthington does not teach or suggest that U-shaped bracket 15 combined with cushion insert 36 has a sloped upper surface, as required by this claim, so Worthington fails to teach or suggest the limitations of claim 15.

Claim 15 further requires “a handle pivotally coupled to the non-pivoted jaw structure”. The Office Action equates the claimed “handle” with a combination of Worthington’s grip 18 and support arms 20 and 22.

Claim 15 further requires “a member pivotally coupled to the handle, the member having a textured surface projecting below the arcuate lower surface of the upper jaw portion and being

opposite to the sloped surface of the lower jaw portion, the textured surface being operable for clamping the portion of the pad against the sloped surface when the handle is pivoted upwards.” The Office Action equates the claimed “member” with Worthington’s plate 14. However, Worthington’s plate 14 does not have “a textured surface projecting below the arcuate lower surface of the upper jaw portion and being opposite to the sloped surface of the lower jaw portion” as required by claim 15, as there is no sloped surface demonstrated to be opposite of. In fact, Worthington describes that “the gripping surfaces 34 and 44 to be oriented so that they are exactly parallel to one another” (see [0023]), so that Worthington teaches directly away from the claimed sloped surface.

As discussed above, Krauss similarly fails to teach or suggest these features, and so does not overcome the shortcomings of Worthington.

As may be clearly seen, the features of claim 15 are not taught or suggested by Worthington, Krauss, or any combination of them and so claim 15 and dependent claims 16-20 should be allowed over Krauss. These rejections are traversed.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

**SUMMARY**


If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: Dec. 6, 2008

  
\_\_\_\_\_  
William A. Munck  
Registration No. 39,308

P.O. Box 802432  
Dallas, Texas 75380  
Phone: (972) 628-3600  
Fax: (972) 628-3616  
E-mail: *wmunck@davismunck.com*